



DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2021-0042]

Extension of the Patent Trial and Appeal Board Motion to Amend Pilot Program

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) is extending the Motion to Amend (MTA) Pilot Program, initiated on March 15, 2019, and first extended on September 16, 2021. The MTA Pilot Program provides additional options for a patent owner who files an MTA in an America Invents Act (AIA) trial proceeding before the Patent Trial and Appeal Board (PTAB). In particular, the program provides a patent owner who files an MTA with options to request preliminary guidance from the PTAB on the MTA and to file a revised MTA. The MTA Pilot Program also provides timelines for briefing to accommodate these options.

DATES: *Applicability Date:* [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER]. *Duration:* The MTA Pilot Program will run until September 16, 2024 (or it may end sooner if replaced by a permanent program after notice-and-comment rulemaking). The USPTO may further extend the MTA Pilot Program (with or without modification) on either a temporary or a permanent basis, or may discontinue the program after that date.

FOR FURTHER INFORMATION CONTACT: Miriam L. Quinn, Acting Vice Chief Administrative Patent Judge; or Melissa Haapala, Vice Chief Administrative Patent Judge; at 571-272-9797 (Miriam.Quinn@uspto.gov or Melissa.Haapala@uspto.gov, respectively).

SUPPLEMENTARY INFORMATION: A patent owner in an AIA trial proceeding may file an MTA as a matter of right. *See* 35 U.S.C. 316(d)(1), 326(d)(1). After receiving public feedback about the PTAB’s MTA practice, in October 2018 the USPTO published a Request for Comments in the Federal Register seeking written public comments on a proposed amendment process in AIA trials that would involve preliminary guidance from the PTAB on the merits of an MTA and an opportunity for a patent owner to file a revised MTA. *See* Request for Comments on MTA Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 83 FR 54319 (Oct. 29, 2018). The majority of comments supported the PTAB issuing preliminary guidance in cases involving an MTA, and commenters were almost evenly mixed in supporting or opposing the opportunity for a patent owner to file a revised MTA.

On March 15, 2019, in response to these public comments, the USPTO issued a Federal Register Notice detailing the MTA Pilot Program. *See* Notice Regarding a New Pilot Program Concerning Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 FR 9497 (Mar. 15, 2019). The MTA Pilot Program provides a patent owner with two options not previously available: (1) a patent owner may choose to receive preliminary guidance from the PTAB on its MTA; and (2) a patent owner may choose to file a revised MTA after receiving a petitioner’s opposition to the original MTA and/or the PTAB’s preliminary guidance (if requested). If a patent owner does not elect either option, then AIA trial practice, including MTA practice, is essentially unchanged from the practice prior to the implementation of the MTA Pilot Program.

The USPTO subsequently extended the MTA Pilot Program on September 16, 2021, to run through September 16, 2022. The USPTO presented the results of the MTA Pilot Program through March 31, 2022, in Installment 7 of the Motion to Amend Study. The

most recent information and statistics related to MTAs are available on the USPTO's website at www.uspto.gov/patents/ptab/motions-amend-study.

Now that stakeholders have had experience with the MTA Pilot Program, as well as access to the results of the Motion to Amend Study, the USPTO plans to issue a Request for Comments regarding the MTA Pilot Program to gather stakeholder feedback and suggestions on the program and on amendment practice generally and to determine whether to make the program permanent through notice-and-comment rulemaking. The USPTO is extending the MTA Pilot Program for a second time, through September 16, 2024, while it gathers public input. The requirements for the program remain as set forth in the original notice without modification.

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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